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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/618,765	07/18/2000	Matthew W. Milne	K35A0623	8823

26332 7590 10/22/2003

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 10/22/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/618,765

Applicant(s)

MILNE ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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1. Claims 1-20 are pending in this application.
2. The request for correction of filing receipt filed on 11/20/2000 has been received and the requested correction of the names of two of inventors has been made.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless :

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-4, 6-8, 11-14, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Welder (US 6,473,855).
5. As to claim 1, Welder discloses the invention as claimed including a method of establishing a connection between a personal computer system and a content delivery server (abstract), the personal computer system including a computing subsystem and a disk drive, the method comprising: providing a network address for the content delivery server (col. 9, lines 13-26); providing a server-contacting program (col. 3, lines 43-58); storing the network address and
or col. 9, lines 13-26

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the server-contacting program in the disk drive (col. 4, lines 13-29); and installing firmware in the disk drive to initiate execution of the server contacting program after the disk drive is connected to the computing subsystem in the personal computer system (col. 7, lines 45-55); wherein execution of the server contacting program includes using the network address for connecting the personal computer system to the content delivery server (col. 9, lines 6-37).

6. As to claim 11, the claim is rejected for the same reasons as claim 1 above. In addition, Welder discloses a computer network (Fig. 1), comprising: a content delivery server having a network address (50, Fig. 1); and a personal computer system comprising a computing subsystem and a disk drive (Fig. 2), wherein the disk drive comprises: a network address; a server-contacting program (col. 4, lines 13-29); and a disk controller circuit for initiating execution of the server contacting program after the disk drive is connected to the computing subsystem in the personal computer system (col. 7, lines 45-55); wherein execution of the server-contacting program includes the using the network address for connecting the personal computer system to the content delivery server (col. 9, lines 6-37; and col. 3, lines 43-58).

7. As to claims 2 and 13, Welder discloses the disk drive includes a protected area; and the network address and the server-contacting program are stored in the protected area (col. 7, lines 46-64).

8. As to claim 3, Welder discloses the firmware resides in a disk controller circuit (col. 6, lines 55-67).

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9. As to claims 4 and 14, Welder discloses the firmware automatically initiates execution of the server-contacting program when the disk drive is connected to the computing subsystem in the personal computer system (col. 3, lines 55-58; and col. 8, lines 52-58)..

10. As to claims 6,7,12, 16, and 17, Welder discloses the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a predetermined period has lapsed or until the firmware determines that a selected number of monitored events exceeds a threshold or upon the occurrence of a selected condition that is determined by the disk controller circuit (col. 11, lines 20-46), the monitored events includes the number of boot-ups in the computing subsystem (col. 2, lines 26-31).

11. A to claims 8 and 18, Welder discloses the personal computer system receives content data from the content delivery server (col. 10, lines 12-15; and col. 15, lines 47-56) and subsequently displays the content during a boot sequence (abstract).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 5, 9, 10, 15, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Welder (US 6,473,855) as applied to claims 1-4, 6-8, 11-14, and 16-18 above, and further in view of Peterson et al. (US 6,594,682), hereafter "Peterson".

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14. As to claims 5 and 15, Welder does not specifically disclose the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a predetermined period has lapsed. Peterson, on the other hand, discloses the firmware (the disk controller circuit) delays initiating execution of the server-contacting program until a predetermined period has lapsed (abstract). It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Welder and Peterson because Peterson's teaching would enhance the performance of Welder's system by allowing execution to take place at pre- scheduled times.

15. As to claims 9 and 19, Welder does not specifically disclose the content of the displayed content data is periodically changed. Peterson, on the other hand, discloses changing the content is periodically. It would have been obvious to one skilled in the art at the time of the invention to combine the teachings of Welder and Peterson because Peterson's teaching of changing the content would provide content updating customized for the user of Welder's personal computer system.

16. As to claims 10 and 20, Welder discloses the content data is selected from the group comprising: a content display program, a game, an entertainment program, a utility program, entertainment data, advertisement data, and music data (inherent in col. 2, lines 51-55).

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Getsin et al. (US 6,529,949) ; Landsman et al. (US 6,516,338) ; Klimenko (US 5,974,547) ; Chiles et al. (US 6,167,567); O'Toole et al. (US 6,345,294); and Morris (US 6,353,848).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai T An can be reached on (703) 305-9678. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Nabil El-Hady, Ph.D., M.B.A.
Primary Patent Examiner
October 16, 2003